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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,196	02/04/2004	Michael L. Jordan	050704/305124	4228
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EXAMINER PORTER, RACHEL L				
ART UNIT		PAPER NUMBER		
3626				
MAIL DATE		DELIVERY MODE		
05/19/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

**Advisory Action**  
**Before the Filing of an Appeal Brief**

**Application No.**

10/772,196

**Applicant(s)**

JORDAN, MICHAEL L.

**Examiner**

RACHEL L. PORTER

**Art Unit**

3626

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 28 April 2009 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.  
Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: none.  
Claim(s) objected to: none.  
Claim(s) rejected: 1-3-6 and 9.  
Claim(s) withdrawn from consideration: 10-17.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

/C. Luke Gilligan/  
Supervisory Patent Examiner, Art Unit 3626

/R. L. P./  
Examiner, Art Unit 3626

Continuation of 11, does NOT place the application in condition for allowance because: The Applicant's arguments have been considered but are not persuasive. Applicant argues the rejection of claims 1, and 3-6 under 35 USC 112, 2nd paragraph.

In response, the involvement of a machine or apparatus is required for a method to be statutory. Claim 1 currently recites "evaluating a queue of orders to determine whether each prescription... is fillable in an automated manner" and "determining a set of workstations for each prescription based on set of said evaluating, wherein if the prescription is fillable in an automated manner..."

As currently written, it is unclear from the claim language of claim 1 whether a machine or apparatus is required to perform the steps of claim 1. Applicant has cited passages on pages 7-9. However, these passages also describe a computer executing a software routine to perform the steps of evaluating and determining. (par. 20-21) These paragraphs also include components of the workstation which participate in the automation of the prescription fulfillment process.

Therefore, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

As currently recited, the claim language does not preclude an individual from picking up a bottle and deciding to manually fill a prescription.

Applicant argues that Hebron does not disclose or suggest "routing any carrier for an order to a pharmacist workstation before routing the carrier to the packing workstation where the order has at least one prescription filled by non-automated equipment, as recited by claim 9. Applicant further argues that Hebron is directed to automated filling, and does not contemplate non-automated prescription filling.

In response, the Examiner disagrees with Applicant's interpretation. Hebron discloses points at which the prescription is re-routed/set aside for pharmacist review, interrupting the automated prescription fulfillment process. (par. 92-99) Prescriptions from the patient fill process are assigned to be filled in an optimal manner. Some prescriptions proceed through the process, why others are determined to be problematic (e.g. will deplete supply on hand), and the system operator or pharmacist must intervene. (par. 95-the process stops or rx is non-assigned) System operators/pharmacists may restock the system or may alter the quantity of drugs dispensed to the patient (par. 99)

These are manual interventions by the pharmacist and system operators in the "automated" system and method disclosed by Hebron. Applicant's claim language fail to clarify the distinction between "non-automated" and "automated" equipment. Furthermore, the claim language fails to recite the steps which are performed by the pharmacist workstation. As such, applicant's arguments are non-persuasive.

Applicant argues the combination of Hebron and Spaulding to address the claim limitations of 1, 3-6.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Spaulding discloses a method wherein prescriptions may be sent to a separate pharmacist review workstation for further processing if there is a discrepancy and the automated process cannot continue (e.g. the rx is not fillable in an automated manner). (col. 11 : 61-67 ; col. 15:5-25) The pharmacist measures and checks the weight of the prescription, only if there is a discrepancy in the weight. Otherwise, the system proceeds without the pharmacist's involvement. (See 112, 2nd rejection)

It is unclear to the examiner how the current claim language, and the use of the terms "non-automated" and "automated" equipment distinguish over the current prior. Therefore, the rejection has been maintained. .